REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-15 and 17 are pending in this application. Claim 16 was previously

canceled without prejudice or disclaimer. Claims 1, 6, 9, 13, and 17 have been amended to

correct typographical errors in Claims 9 and 13 and to avoid ambiguities in Claims 1, 9, and

17. As the changes all relate to formal matters that do not introduce any new matter or

require further search or other consideration, entry is respectfully requested.

The outstanding Office Action presents a rejection of Claims 1-5 and 9-15 as being

unpatentable over Numao (U.S. Patent No. 6,377,688) in view of Moore et al. (U.S. Patent

No. 7,165,268) under 35 U.S.C. §103(a) and a rejection of Claims 6-8 and 17 as being

unpatentable over Numao in view of Maruyama (U.S. Patent Application Publication No.

2002/0144118) under 35 U.S.C. §103(a).

WITHDRAWAL OF IMPROPER OFFICE ACTION

The rejection of Claims 6-8 and 17 as being unpatentable over Numao in view of

Maruyama under 35 U.S.C. §103(a) as stated at the bottom of page 8 of the outstanding

action appears to be an error because pages 10-12 of the outstanding Action set forth

improper reliance on the teachings of Moore in addition to those of Numao and Maruyama.

These incorporations of teachings from Moore are improper as the statement of this rejection

does not positively include any indication of reliance on Moore, see MPEP 706.02(j) as

follows:

> Where a reference is relied on to support a rejection, whether or not in
> a minor capacity, that reference should be positively included in the statement
> of the rejection. See *In re Hoch,* 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407
> n. 3 (CCPA 1970).

Accordingly, the outstanding Office Action is clearly improper and should be

withdrawn as it has repeated the rejection of Claims 6-8 and 17 as being unpatentable over

Numao in view of Maruyama under 35 U.S.C. §103(a) without positively including Moore in the statement of the rejection while seeming to rely on Moore to support the rejection.

RESPONSE TO STATED REJECTIONS

With respect to the rejection of Claims 1-5 and 9-15 as being unpatentable over Numao in view of Moore under 35 U.S.C. §103(a), it is noted that Numao fails to teach or suggest more than what page 3 of the outstanding Action admits as to there being no teaching "that the message delivered is a tangible item with a tangible encrypted medium." For example, Numao also fails to teach or suggest that "a public switched telephone network is used" to make a "connection between a sender's terminal apparatus of a sender and a recipient's terminal apparatus of a recipient" as independent Claims 1 and 9 require.

Furthermore, col. 4, lines 9-12, of Numao are relied on with col. 6, lines 20-51 (at the top of page 3 of the outstanding Action) as teaching the independent Claim 1 recital of "the recipient's terminal apparatus is configured to obtain a public key from the delivery agency via a specified medium, to use the public key so obtained to encrypt recipient information as recipient's encryption information containing at least private information needed to enable delivery of tangible items to the recipient, and to transmit the recipient's encryption information to the sender's terminal apparatus." However, the outstanding Action presents no explanation as to how these separate teachings are being considered together to teach this claimed subject matter.

In this regard, the teaching of col. 4, lines 9-12, of Numao is that FIG. 3 shows transmitter 110 as having an encryption means 112 that encrypts a message M into an encrypted message MO using public keys P and N created by a server 130 and an encrypted message transmission means 114 that sends the thus encrypted message M0 to a receiver 120. Accordingly, as the transmitter 110 has the encryption means 112 that encrypts the message

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M using public keys P and N created by the server 130, the outstanding Action must be interpreting the Claim 1 "recipient's terminal apparatus" that uses the public key as corresponding to transmitter 110 and the Claim 1 "delivery agency" as corresponding to the server 130 that creates and supplies the public key to the transmitter 110. Further, as the encrypted message MO is taught to be sent from transmitter 110 to receiver 120, this suggests that receiver 120 is being interpreted as the Claim 1 recited sender's terminal apparatus.

Furthermore, it appears that the outstanding Action is then suggesting that the item "1." "server" of col. 6, lines 20-21, can be said to correspond to server 130, that the item "3." "sender" of col. 6, lines 27-30, can be said to correspond to transmitter 110, and that the item "4." "recipient" of col. 6, lines 31-34, can be said to correspond to the receiver 120.

Even assuming the above analysis is correct, the certificate taught by item "2." of col. 6, lines 22-26, of Numao cannot be correlated to the Claim 1 requirement for the use of the public key to encrypt recipient information as recipient's encryption information containing at least private information needed to enable delivery of the tangible item to the recipient. In this regard, the certificate that is taught by Numao to be created by the "server" of col. 6, lines 20-21, (corresponding to server 130 and being apparently interpreted to correspond to the Claim 1 "delivery agency") is forwarded to the "sender" of col. 6, lines 27-30, (corresponding to transmitter 110 of Numao being apparently interpreted to correspond to the Claim 1 "recipient") that in turn forwards the certificate without any disclosed encryption processing using the public key to the "recipient" of col. 6, lines 31-34, (corresponding to the receiver 120 being apparently interpreted to correspond to the Claim 1 "sender") along with the encrypted message MO.

However, even if it can be said that the "certificate" includes "private information" as to the IDs noted at col. 6, line 24, this certificate with IDs is not taught to be encrypted using the public key by the "sender" of col. 6, lines 27-30 (correspond to transmitter 110) as

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required of the Claim 1 "recipient's terminal apparatus" so as to be part of the Claim 1 "recipient's encryption information."

Further in this regard note that the server 130 (corresponding to the above-noted "server") has the private key to decrypt the message M1 from receiver 120 (corresponding to the above-noted "recipient"), but this M1 decryption is clearly not used as to the certificate because the certificate is used to verify the "recipient" (receiver 120) **before decryption** as noted at col. 6, lines 37-39 of Numao. Message M1 is encrypted message MO after the further encryption of MO using random number X, see FIG. 3, element 124.

As no decryption using the private key is taught by Numao as being required to read the certificate, there is no teaching or suggestion here of the Claim 1 requirement that "the delivery agency has a cryptogram reader configured to read and **decrypt the tangible encrypted medium carrying or storing the recipient's encryption information using a secret key known only to the delivery agency so that the delivery agency obtains the private information from the decrypted tangible encrypted medium**" (emphasis added).

Also, col. 4, lines 13-22, of Numao further relied on as to this Claim 1 requirement teaches nothing as to this Claim 1 recited delivery agency cryptogram reader that "reads and decrypts the tangible encrypted medium carrying or storing the recipient's encryption information using a secret key known only to the delivery agency so that the delivery agency obtains the private information from the decrypted tangible encrypted medium." Instead, this portion of Numao simply teaches that the server 130 includes decryption means 136 that uses a secret key to decrypt the encrypted message M1 sent from receiver 120. Message M1 is not taught or suggested to contain any private information like the unencrypted certificate of item "2."of col. 6, lines 22-26, of Numao.

If the PTO is trying to suggest that Numao teaches that encrypted messages M1 and/or MO contain the independent Claim 1 recited "private information needed to enable

delivery of tangible items to the recipient," or that Numao teaches that the certificate is encrypted like messages MO and/or M1, the PTO is called upon to explain where it finds such teachings in Numao. *See In re Rijckaert*, 9 F. 3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) ("When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.").

On the other hand, if the PTO is ignoring or not giving patentable weight to the independent Claim 1 recital of "private information needed to enable delivery of tangible items to the recipient," the PTO is in violation of precedent that requires an analysis as to all claim limitations, even as to message content. *See Gechter v. Davidson* 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (For example, the [PTO] does not separately construe the term "agent status messages" before finding that [the reference] discloses just such "agent status messages.").

In addition, the outstanding Action suggests that the Moore disclosure of sending a tangible medium that contains a sender encrypted content message and an encrypted authentication message to a recipient somehow cures the deficiencies of Numao. However, even if the message MO from 110 to 120 were sent as the suggested tangible media, the intent of Numao is that 120 cannot itself decrypt this message which is the opposite of the intent and purpose of Moore as to the entity intended to receive the message being authorized to itself decrypt it. Thus, including the encrypted authentication message of Moore for the intended message recipient 120 of Numao is clearly contrary to the teachings and suggestions of Numao. Accordingly, the outstanding Action fails to establish any reasonable basis to suggest that the artisan would have been led to even attempt such a modification that is contrary to the intended operation of Numao in which 130, not 120, performs authentication. *See In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) ("rejections on

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obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness") and *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959) noting that proposed modifications that would change the basic operating principle of a reference are not obvious.

Further, both Numao and Moore teach sending an encrypted message from the message originator to the authorized recipient. In Moore this is done directly while in Numao the message MO created by the sender 110 is passed through the intended recipient 120 to the server 130 as message M1, and server 130 uses the secret key to create and relay a decrypted message M2 back to the recipient 120 that 120 can read. Accordingly, even if the messages were all converted to the tangible form taught by Moore, there is still no tangible message delivered to the recipient that can only correspond to 110 of Numao. In this regard, independent Claim 1 requires that "the delivery agency obtains the private information from the decrypted tangible encrypted medium to enable the tangible item to be delivered to the recipient."

Accordingly, the rejection of independent Claim 1 is respectfully submitted to be improper and withdrawal thereof is requested.

Independent Claim 9 is similar to independent Claim 1 and specifically requires that it is the delivery agency which delivers the "tangible item to a recipient that has been forwarded to the delivery agency by a sender along with a tangible encrypted medium carrying or storing encrypted information needed to deliver the tangible item to the recipient." Again, neither Numao nor Moore teach or suggest that the server 130 of Numao (that is treated in the outstanding Action as corresponding to the claimed delivery agency as noted above) delivers anything tangible to the transmitter 110 (that is treated in the outstanding Action as corresponding to the claimed recipient as noted above).

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Furthermore, independent Claim 9 recites "a means for outputting the decrypted information needed to deliver the tangible item to the recipient as human-readable recipient information" that is asserted in the outstanding Action to be taught by col. 4, lines 65-66. However, col. 4, lines 65-66 of Numao only teach changing an encrypted message to plain text which is well understood in the art to mean unencrypted data. Providing "human-readable recipient information" is not taught by the conversion of encrypted data to decrypted plain text.

Also, and as noted in the above cited *Gechter v. Davidson* decision, the PTO must construe "the scope of the structures disclosed in the specification for the claimed . . . means" and explain why these specification disclosed "means" are structurally equivalent to the structure embodied in the reference relied on to teach them. Here, none of the "means" of independent Claim 9 have been so construed and no explanation is offered as to how the **functions** listed at col. 6, lines 60-65 are "**structurally equivalent**" to the structures disclosed in the specification for performing the functions actually recited in Claim 9.

Accordingly, the rejection of independent Claim 9 is also respectfully submitted to be improper and withdrawal thereof is requested.

Independent Claim 11 is a method claim that essentially recites the subject matter of independent Claim 1 in method format. Accordingly, this method claim defines over the teachings and reasonable suggestions of Numao and/or Moore taken alone or together in any proper combination for the reasons noted above as to independent Claim 1.

Accordingly, the rejection of independent Claim 11 is also respectfully submitted to be improper and withdrawal thereof is requested.

Claims 3-5 directly depend from independent Claim 1, Claim 10 directly depends from independent Claim 9, and Claims 12-15 directly depend from independent Claim 11. Accordingly, dependent Claims 3-5, 10, and 12-15 are respectfully submitted to patentably

define over Numao and/or Moore taken alone or together in any proper combination for the reasons noted above as to independent Claims 1, 9, and 11, respectively. In addition, dependent Claims 3-5, 10, and 12-15 are respectfully submitted to patentably define over Numao and/or Moore taken alone or together in any proper combination because the features that these dependent claims add to their respective independent claims are also not taught or suggested thereby.

Accordingly, the rejection of dependent Claims 3-5, 10, and 12-15 is also respectfully submitted to be improper and withdrawal thereof is requested.

The rejection of Claims 6-8 and 17 as being unpatentable over Numao in view of Maruyama under 35 U.S.C. §103(a) is traversed as Numao taken alone or in any proper combination with Maruyama does not teach or suggest a tangible item delivery system or a computer-readable tangible storage medium carrying a program for a computer of a delivery agency which delivers a tangible item to a recipient by a sender in which the tangible item is first sent by the sender to a delivery agency with an encrypted medium that contains at least the information needed to deliver the tangible item to the recipient where only the delivery agency has the private key that can decrypt this information to permit delivery of the tangible item to the recipient.

As was noted in the last response, "[t]o the extent that the outstanding Action appears to have misinterpreted the previously presented claim terminology requiring "delivery" items as messages, such misinterpretations are no longer possible." As was also noted in this response, "[i]t is further impossible to find any teaching or suggestion in Numao of the forwarding of the tangible item with a tangible encrypted medium carrying or storing the recipient's encryption information to a delivery agency by the sender, a feature present in all of the pending claims that is either expressly recited or incorporated by virtue of claim dependency." This lack of any teaching or suggestion in Numao of the forwarding of the

tangible item with a tangible encrypted medium carrying or storing the recipient's encryption information is further admitted at the bottom of page 3 of the outstanding Action (admitting "that Nomao does not explicitly teach that the message delivered is a tangible item with a tangible encrypted medium"). Even if it could be said that <u>Maruyama</u> teaches transmitting a public key in response to a request from the recipient terminal, as noted at the bottom of page 9 of the outstanding Action, this fails to cure the above noted deficiencies of <u>Numao</u> as <u>Maruyama</u> also does not teach or suggest the above noted claim requirement of the forwarding of the tangible item with a tangible encrypted medium carrying or storing the recipient's encryption information to a delivery agency by the sender.

To whatever extent that <u>Moore</u> has been mentioned in the body of the rejection as to Claims 6, 7, and 17, a reference being relied upon must be included in the statement of the rejection as noted above. As <u>Moore</u> has not been so included, it is not discussed in detail beyond noting that it lacks teachings to cure the above noted deficiencies of <u>Numao</u> as to the requirement of independent Claims 6 and 17 to obtain "private information needed to enable delivery of tangible items to the recipient."
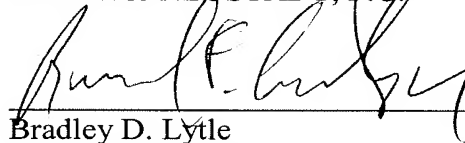
In any event, as <u>Maruyama</u> cures none of the above-noted deficiencies of <u>Numao</u>, withdrawal of the stated rejection of Claims 6-8 and 17 as being unpatentable over <u>Numao</u> in view of <u>Maruyama</u> is respectfully requested.

As no further issues are believed to remain outstanding in the present application, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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